

REMARKS

The present reissue application is believed to be in condition for allowance at the time of the next Office Action.

The Official Action states that the disclosure is objected to for failing to include a cross-reference to the continuation of the reissue application 11/354,321. Accordingly to the public records of the USPTO, the identified application is that of Mark Alan LITTELL, and is directed to a Male Genital Protection Device.

While earnestly desiring to fully respond to the present Office Action, Applicant is at a loss as to how to respond to this objection. Reconsideration and withdraw of this objection are therefore respectfully requested.

In a section of the Official Action under the heading "Priority" the Official Action states the following:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112.

The disclosure of the prior-filed application, Application No. 09/445,176 or/and PCT/FR98/01119, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. (citations omitted)

The Official Action goes on to state that in the original reissue oath, Applicant states that one limitation of original claim 1 is not supported by their priority document. As claim 1 is still pending and such limitation is still in the claim, this claim is being examined without the benefit of the earlier priority date.

Applicant notes that under the U.S. practice the requirement for support under 35 U.S.C. 112 exists in a number of contexts. The requirement applies to continuations and divisionals with respect to the parents of such application, as defined under 35 U.S.C. 120. The requirement also applies to Requests for Continued Examination under 37 CFR §1.114. As well, U.S. applications filed under 35 U.S.C. 371 are similarly bound with respect to the PCT applications of which they represent the National Stage.

In each of these situations, the amendment of an application to include content that does not find support under 35 U.S.C. 112 in the parent application constitutes the proscribed addition of new matter.

There is no such requirement for 35 U.S.C. 112 support, however, in the relationship between a U.S. or effective U.S. application that makes a priority claim to a "foreign" application. Such relationship is defined under the Paris Convention and 35 U.S.C. 119(a)-(d).

In the present case, the priority application is the Irish Application S970411 filed June 3, 1997. Exactly one year later Applicant filed International Application PCT/FR98/01119. US Application 09/445,176 was properly filed on March 2, 2000 as the U.S. National Stage of such PCT application, and issued July 31, 2001 as US Patent No. 6,267,765. It is such patent for which the present application seeks reissue.

The lack of support to which the reissue oath refers relates only to a difference between the PCT application of June 3, 1998 and the Irish Application of June 3, 1997. There has been no introduction of new matter at any point during the prosecution of the PCT application, the prosecution of U.S. National Phase Application No. 09/445,176, or the present reissue application. All content and amendments of the present reissue application find full support under 35 U.S.C. 112 in PCT/FR98/01119 of June 3, 1998.

The referred-to content in the PCT application that is absent from the Irish priority application means only that the U.S. Applicant cannot rely on the Irish application as incontrovertible proof of a latest possible date of invention for any claim that does not find full support under 35 U.S.C. 112 in such Irish application. However, every claim in the issued US Patent 6,267,765 and every claim pending in the present reissue application finds complete support in the PCT application.

As a consequence, each of the pending claims must be construed as having an effective U.S. filing date of June 3, 1998. Beyond that, any claim of the pending reissue application that is fully supported by the Irish application has an incontrovertible latest possible date of invention of June 3, 1997. Any claim not so supported then has a latest possible date of invention of June 3, 1998.

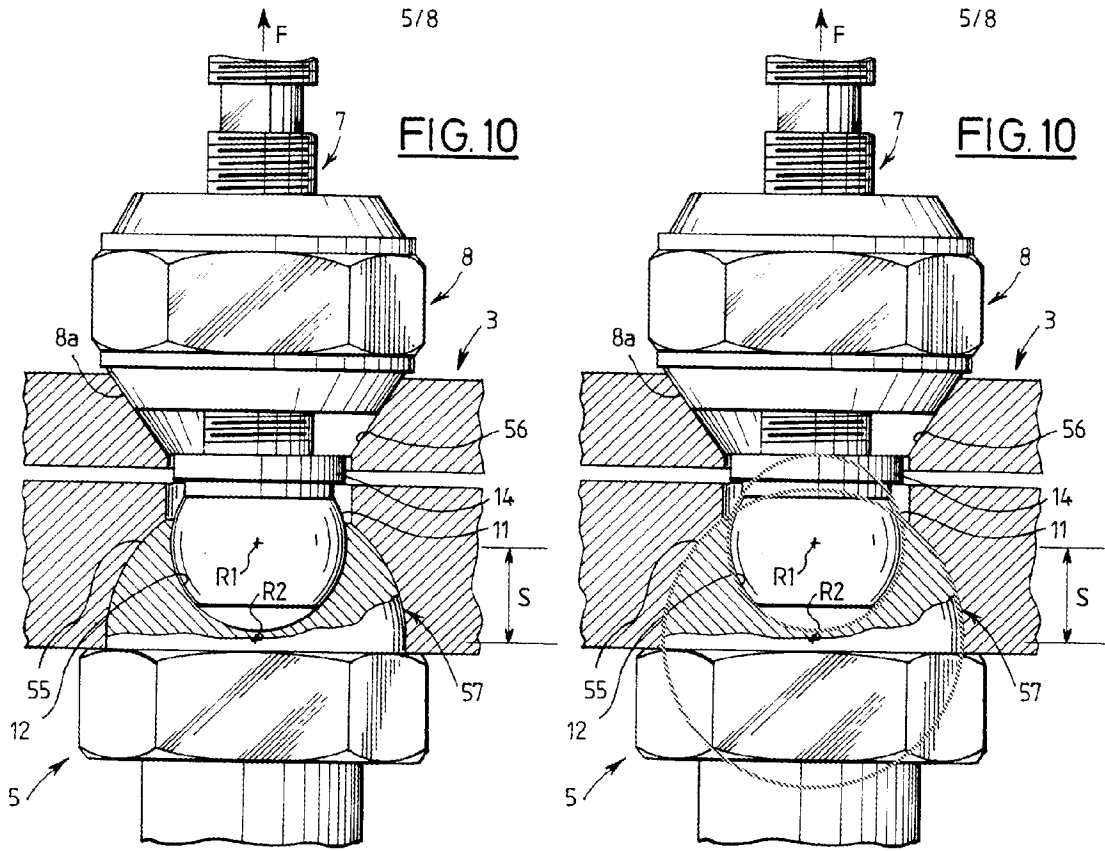
Counsel for Applicant confesses considerable difficulty in understanding the basis of the priority analysis appearing in the outstanding Official Action. It is assumed, however, that the Official Action statement that "[claim 1] would be examined WITHOUT the benefit of the earlier priority date" means that the present claim 1 is being examined as though it has a filing date and latest provable date of invention of July 30, 2003, the filing date of the present reissue application.

In light of the detailed analysis above, Applicant respectfully suggests that such conclusion is entirely unsupported. As this misunderstanding appears to underlie the rejection based on prior art discussed below, the reconsideration and withdrawal of both that and any other rejection or objection based upon such analysis are respectfully requested.

The Official Action rejects claims 1-13 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Reconsideration and withdraw of this rejection are respectfully requested for the following reasons:

The Official Action states that claims 1 and 3 were amended from an original recitation that the ball and cup have respective centers of rotation separated by a given distance to recite instead that the ball and exterior surface of the head have respective centers of rotation separated by distance S.

Applicant notes that the language in question of amended reissue application claim 1 reads "the ball (11) and an exterior surface of the head have respective centers of rotation (R1, R2) which are separated by a distance (S)..." In this regard, Applicant makes specific reference to present Figure 10, which appears identically in the current reissue application, the U.S. Patent whose reissue is now sought, and the PCT application whose U.S. National Phase ultimately issued as such patent. The drawing is reproduced below in original form on the left, and in annotated form on the right:



In such illustration, the bone anchoring element includes head 5. The head 5 has a generally hemispherical exterior surface. The rotational center of such generally hemispherical surface is R2. This is clear from the annotated drawing on the right that adds a circle centered at R2. As is clear from the annotated drawing, such circle aligns exactly with the exterior surface of the head.

The device also includes ball end 11. As is also shown by the annotated drawing, a circle having center R1 corresponds exactly to the spherical portion of the ball end 11. The distance S between R1 and R2 appears in figure 10 originally.

Accordingly, the language in question of claims 1 and 3 is believed to find complete support in the application as originally filed. Reconsideration and withdrawal of this rejection are therefore respectfully requested.

The Official Action states that the amendment filed November 10, 2008 is non-compliant because the Applicant provides a list of the status of claims that includes claims 21 and 25, even though such claims were cancelled in the amendment of June 20, 2007. Applicant apologizes for the oversight and herein states the status of each claim and where the current form of each claim can be found are as follows:

1. pending (amendment of May 31, 2005);
2. pending (unchanged from issued patent);
- 3-5. pending (amendment of May 31, 2005);
- 6-12. pending (original patent)
13. pending (amendment of May 31, 2005);
14. canceled (present amendment);
15. canceled (amendment of June 20, 2007);
- 16, 17. pending (amendment of May 31, 2005);
- 18-20. pending (amendment of July 30, 2003);
21. canceled (amendment of June 20, 2007);
22. canceled (present amendment);
- 23, 24. pending (amendment of July 30, 2003);
25. canceled (amendment of June 20, 2007);
- 26-28. pending (amendment of July 30, 2003);

29, 30. pending (amendment of May 31, 2005);

31-35. canceled (present amendment).

The Official Action rejects claims 16-20, 23, 24, and 26-30 under 35 U.S.C. 251 as being improperly broadened in a reissue application. Reconsideration and withdraw of this rejection are respectfully requested for the following reasons:

Applicant wishes to respond fully to the present rejection, but is unable to do so. The Official Action refers to "the limitation" and claim 25 without identifying what "the limitation" is. It is also unclear to Applicant whether the claim 25 in question refers to reissue application 25 or original application 25. The Office Action also fails to indicate when and how such limitation was added to overcome a rejection.

At the outset, Applicant notes that the present reissue application is a broadening-type reissue. Accordingly, the expanded scope of claims as compared to those of the issued patent is not prohibited *per se*. It is also unclear to Applicant whether the rejection under 35 U.S.C. 251 is based on the doctrine of prohibited reissue recapture. The rejection appears to make reference to amendments made during prosecution of the application that resulted in the original patent, but includes none of the detailed analysis that must accompany a rejection under reissue recapture.

Accordingly, Applicant respectfully requests that the present rejection be reconsidered and withdrawn. If the



rejection is maintained, the analysis underlying such rejection is solicited.

The Official Action rejects claims 1-13 under 35 U.S.C. 102(e) as being anticipated by ALTERAC et al. The Official Action points out the preceding question of the priority claim, discussed above. It is Applicant's understanding that the present rejection over prior art is contingent upon the Office Action's assertion as to the lack of support under 35 U.S.C. 112.

The ALTERAC et al. patent has a U.S. filing date of February 7, 2003. The application underlying the ALTERAC patent makes a priority claim to a provisional application filed February 13, 2002. Regardless of whether the relied-upon content of the ALTERAC et al. reference is entitled to the regular or provisional filing date, each falls much later than the PCT filing date of June 3, 1998 to which the present application is entitled as its effective U.S. filing date. Accordingly, the ALTERAC et al. patent constitutes prior art under neither 35 U.S.C. 102(e) nor any other section of 35 U.S.C. 102. Reconsideration and withdraw of this rejection are therefore respectfully requested.

Applicant's note that the present filing makes no amendment to the reissue application or takes any other step that, in itself, necessitates further search or examination. Accordingly, Applicant notes that if the next action on the

merits includes the withdrawal of any of the pending rejections and any new rejection, such rejection must be non-final.

Applicant notes also that the recent course of prosecution of the present reissue has been irregular and has caused considerable unnecessary time and expense to the Applicant. This application has already been placed in condition for allowance, which allowance was subsequently withdrawn. The stated bases for objection and rejection in the Office Action to which the present paper responds are difficult to understand, at best. Applicant therefore respectfully asks that the present application be forwarded expeditiously, once again, to allowance.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future submissions, to charge any deficiency or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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